

(Practitioner's Docket No. IPAT-01033/BC1-0064)

REMARKS

Upon entry of the present amendment claims 1-3, 5-7, and 9 are pending in the application. Claim 9 has been amended in accordance with the requirements of U.S. patent practice. Applicants respectfully request entry of the amendment.

1. Allowable Subject Matter

The PTO has indicated that claims 1-3 and 5-7 are allowable. Applicants greatly appreciate the indication of allowable claims.

2. Rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Fryling, U.S. 2,396,997, hereafter "Fryling" or "997".

Claim 9 stands rejected as obvious over Fryling. The PTO states:

"... while claim 1 has been amended to require a reaction product of an organic compound containing at least one isocyanate group and at least one thiol, claim 9 is not so limited. Instead, the latter *independent* claim (re-presented in original form) merely requires regulating free-radical (co)polymerization of at least one olefinically unsaturated monomer by adding a thiocarbamate-functional organic compound to the (co)polymerization. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims."

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree in regard to the invention of amended independent claim 9.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met by the disclosures of Fryling. In particular, Fryling fails to teach or suggest all of the required claim limitations of amended Independent claim 9. Independent claim 9 has been amended to require that the at least one

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thiocarbamate-functional organic compound comprising a reaction product of an organic compound containing at least one isocyanate group and at least one thiol.

In this case, nothing in Fryling teaches or suggests the use of the particular thiocarbamates obtained by the reaction of the particular structures of Applicants' thiocarbamates resulting from the reaction of a thiol and an isocyanate functional compound. Even if the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed Cir. 1989).

In this case, nothing but Applicants' own teachings provide that suggestion. The CAFC has stated "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore & Assocs., Inc., v. Garlock*, 220 U.S.P.Q. 303, 312-313. (Fed. Cir. 1983).

Accordingly, it is respectfully submitted that Fryling fails to provide a *prima facie* case of obviousness with regard to the invention of amended independent claim 9.

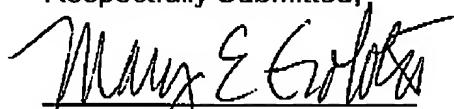
Reconsideration and removal of the rejection is respectfully requested in view of the foregoing amendments and remarks.

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CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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